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| MICHAEL BEST & FRIEDRICH LLP | | | EXAMINER | |
| 100 E WISCONSIN AVENUE | | | YEAGLEY, DANIEL S | |
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY E. RICHLEN,
DANIEL A. MATRE, JAMES M. BUSSE, and
NELSON J. COBB

Appeal 2008-0452
Application 10/611,620
Technology Center 3600

Decided: March 7, 2008

Before HUBERT C. LORIN, LINDA E. HORNER, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Richlen, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 17-19, 21-23, 33, 35-37, 39-41, 43, and 45. (App. Br. 2). Claims 39-41 and 43-45 are now indicated as allowed. (Answer 5). Accordingly, Appellants are seeking review of only claims 17-19, 21-23, 33, and 35-37.

However, the claims which have been rejected are claims 17-23 and 33-37.¹ (Final Rejection 3). Accordingly, the Appellants have decided not to contest the final rejection of claims 20 and 34. According to 37 C.F.R. § 41.31(c) (2007), “[a]n appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest.” Because the Appellants have decided not to contest the final rejection of claims 20 and 34, the Appellants are deemed to have withdrawn the appeal as to claims 20 and 34.

We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.²

THE INVENTION

The invention relates to an apparatus for mounting an electronic device to a motorcycle riser. Claim 17 is illustrative of the invention.

17. A break-away mounting system for mounting an electronic device to a motorcycle that includes a motorcycle riser having an upper portion and a lower portion that at least partially attach a handlebar to the motorcycle, the break-away mounting system comprising:

¹ Claims 1-16 and 24-32 have been cancelled. Claim 38 was objected to and indicated as allowable but for the objection. (Final Rejection 4). Claim 42 is only objected to. (Answer 3).

² Our decision will make reference to Appellants’ “Replacement Appeal Brief” (“Br.”, filed Dec. 14, 2005) and the Examiner’s Answer (“Answer,” mailed Mar. 8, 2006).

a first bracket connectable to at least one of the upper portion and the lower portion with a fastener;

a second bracket connectable to the electronic device and detachably connected to the first bracket, wherein rotation of the second bracket relative to the first bracket disengages the second bracket from the first bracket.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|-----------|--------------------|---------------|
| Murayama | US 4,473,251 | Sep. 25, 1984 |
| Willey | US 5,732,965 | Mar. 31, 1998 |
| Stanberry | US 2002/0131606 A1 | Sep. 19, 2002 |

The following rejections are before us for review:

- Claims 17, 18, 21, and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Murayama.
- Claims 17, 18, 19, 21, 22, 33, and 35-37 are rejected under 35 U.S.C. § 102(b) as being anticipated by Willey.
- Claims 17, 18, 22, and 23 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stanberry.

ISSUES

The first issue is whether the Appellants have shown that the Examiner erred in rejecting claims 17, 18, 21, and 22 as being anticipated by Murayama.

The second issue is whether the Appellants have shown that the Examiner erred in rejecting claims 17, 18, 19, 21, 22, 33, and 35-37 as being anticipated by Willey.

The third issue is whether the Appellants have shown that the Examiner erred in rejecting claims 17, 18, 22, and 23 as being anticipated by Stanberry.

These issues, in part, turn on, whether the cited references show a “riser.”

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The term “riser” refers to a “vertical pipe.” (Dictionary.com: <http://dictionary.reference.com/browse/riser>; entry 4. “a vertical pipe, duct, conduit”).
2. Murayama is directed to a motorcycle equipped with an audio device attached to its front cowl.
3. Willey is directed to a system for removably mounting an accessory to a motorcycle.
4. Willey shows an element 94 at the upper portion of pivot latch 88 (Fig. 6; see also col. 5, l. 66) which is substantially C-shaped.
5. Willey shows an element 82 as part of an element 84 included in a main plate. (Fig. 6; see also col. 5, l. 56).

6. Stanberry is directed to an audio system removably mounted on a motorcycle windshield.

PRINCIPLES OF LAW

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

ANALYSIS

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The rejection of claims 17, 18, 21, and 22 as being anticipated by Murayama.

We will not sustain this rejection.

The Examiner argued that Murayama describes the claimed invention. (Answer 3-4).

The Appellants argued that the Examiner has not shown that Murayama describes a bracket *connected* to a riser. However, as the Examiner has correctly pointed out (Answer 4), the language of the claims (i.e., claim 17: a “break-away mounting system *for mounting an electronic device to a motorcycle that includes a motorcycle riser* having an upper portion and a lower portion ... a first bracket *connectable* to at least one of the upper portion and the lower portion with a fastener”, emphasis added) is such that the claimed break-away system need only be *capable* of being connected to the motorcycle’s riser. The claims do not require a bracket to be directly connected or even connected to the riser. All that is required is that the mounting bracket be “*connectable*” to a riser.

The Appellants also argued that Murayama does not describe a fastener, and thus Murayama does not describe all the limitations of the claimed invention. (Br. 8). We agree. The Examiner responded by arguing that “the first brackets for each reference is connected to the riser through other components of the motorcycle by some sort of fastening means, e.g. screws, bolts, welds, or some other part of the motorcycle” (Answer 6). However, this appears to be a matter of speculation. We do not see a fastener for rendering the bracket connectable to a riser described in Murayama. While the claims call for the bracket to be *connectable* to the riser, the claimed invention nevertheless requires the presence of a fastener to accomplish that function. Since Murayama describes no fastener, Murayama fails to anticipate the claimed invention. A *prima facie* case of anticipation of the claimed invention over Murayama has not been established.

The rejection of claims 17, 18, 19, 21, 22, 33, and 35-37 as being anticipated by Willey.

Claims 17, 18, and 22

The Appellants argued claims 17, 18, and 22 as a group (Br. 10). We select claim 17³ as the representative claim for this group, and the remaining claims 18 and 22 stand or fall with claim 17. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argued that the Willey device “is not connectable to a riser nor is it connectable to a riser using a fastener.” (Br. 19). According to the Appellants, “Willey does not teach a first bracket that is connectable to a riser if the proper definition of a ‘riser’ is applied.” (Br. 10). Specifically, the Appellants contended that the Examiner’s “definition of a riser does not conform with the Applicant’s definition nor does it conform with the definition of a riser as understood by one of ordinary skill in the art.” (App. Br. 10).

However, the Specification provides no definition for the term “riser” in light of which the Examiner could have construed the term. And the Appellants have submitted no evidence to support the assertion that the Examiner’s definition does not conform to the definition of a “riser” as understood by one of ordinary skill in the art. We find no evidence supporting the Appellants’ contentions elsewhere in the record. See generally, *In re Glass*, 474 F.2d 1015, 1019 (CCPA 1973); *In re Ludtke*, 441 F.2d 660, 663-64 (CCPA 1971). Given no definition for the term “riser” in the record, the Examiner properly gave the term its ordinary and customary meaning, which is a vertical pipe. (FF 1). In that regard, the Examiner

³ See *supra*.

(Answer 4) directed the Appellants to “the part of the fork tubes that are below the spacer 56” (see Fig. 2), which “fork tubes” appear to be vertical pipes and have not been challenged as being otherwise.

Accordingly, the Appellants have not shown error in the rejection.

Claims 19, 33, 35, and 37

The Appellants argued claims 19, 33, 35, and 37 as a group (Br. 11). We select claim 19 as the representative claim for this group, and the remaining claims 33, 35, and 37 stand or fall with claim 19. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim 19 requires the “second bracket [to] include[] an attachment portion that is substantially C-shaped.”

The Appellants argued that Willey does not disclose an attachment portion to the second bracket that is substantially C-shaped. “The Examiner failed to identify a component analogous to a C-shaped portion. Thus, Applicants are left to guess as to which components the Examiner believes teach the claim limitations.” (Br. 12).

However, the Examiner relied on Willey element 88 as the second bracket. (See Final Rejection 3). In the Answer, the Examiner elaborated, indicating that element 94 of Fig. 5 of Willey shows a substantially C-shaped attachment portion. (Answer 4). According to Willey, element 94 is the upper portion of element 88. (Col. 5, l. 66). That portion, which can be better seen in Fig. 6 of Willey, is substantially C-shaped. FF 4.

Accordingly, we will sustain the rejection as to claims 19, 33, 35, and 37.

Claim 21

We will not sustain the rejection as to claim 21.

Claim 21 further limits the mounting system of claim 17 such that “the second bracket includes legs that contact the first bracket along a line of contact.”

The Examiner argued that Willey teaches “a second bracket 88 . . . having legs (opposite side edges of element 82; figure 6, that contact the first bracket along a line of contact)” (Answer 4). The Appellants argued that “the pivot latch [i.e., element 88] does not include any features that would constitute legs.” (Br. 13).

We agree with the Appellants. Element 82, on which the Examiner relies as a teaching of “legs,” is a part of element 84, not element 88. See Fig. 6 of Willey. Element 84 is included in the main plate (Willey, col. 5, l. 56), not in the pivot latch 88. FF 5.

Claim 36

Claim 36, like claim 21, further limits the mounting system such that “the second bracket includes legs that contact the first bracket along a line of contact.” The Examiner makes the same argument in support of the rejection of this claim as was made in support of the rejection of claim 21. (Answer 4.) Because we found that argument unpersuasive as to the rejection of claim 21, we find it likewise unpersuasive as to the rejection of claim 36.

The rejection of claims 17, 18, 22, and 23 as being anticipated by Stanberry.

The Appellants argued claims 17, 18, 22, and 23 as a group (Br. 11). We select claim 17 as the representative claim for this group, and the remaining claims 18, 22, and 23 stand or fall with claim 17. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argued that Stanberry shows audio equipment being attachable to windshield struts, not a riser. (Br. 17). Appellants do not argue that the audio equipment of Stanberry is not capable of being connected to a riser but only that Stanberry's struts are not risers as that term is known to those of ordinary skill and thus Stanberry fails to show the brackets connectable to risers. (Br. 17). Notwithstanding that the Appellants have submitted no evidence of what those of ordinary skill in the art would understand the term "riser" to mean, the fact that Stanberry discloses its brackets being connected to struts is not dispositive of the lack of anticipation of the claimed subject matter. The claimed brackets are "connectable" to a riser. The claims do not limit the brackets such that they are connected to risers. Nor do the claims limit the brackets from being connectable to struts. The question is whether Stanberry's brackets are capable of being connected to risers of a motorcycle. The Examiner has answered that question by presenting a *prima facie* case of anticipation. The Appellants have not rebutted the *prima facie* case with a persuasive argument to the contrary.

Accordingly, error in the rejection has not been shown.

CONCLUSIONS OF LAW

The Appellants have shown that the Examiner erred in rejecting claims 17, 18, 21, and 22 as being anticipated by Murayama.

The Appellants have not shown that the Examiner erred in rejecting claims 17-19, 22, 33, 35, and 37 as being anticipated by Willey.

The Appellants have shown that the Examiner erred in rejecting claims 21 and 36 as being anticipated by Willey.

The Appellants have not shown that the Examiner erred in rejecting 17, 18, 22, and 23 as being anticipated by Stanberry.

DECISION

The decision of the Examiner rejecting claims 17-19, 22, 23, 33, 35, and 37 is affirmed. The decision of the Examiner rejecting claims 21 and 36 is reversed.

We authorize the Examiner to cancel withdrawn claims 20 and 34 from the application. (*See the Manual of Patenting Examining Procedure* (MPEP § 1215.03).

AFFIRMED-IN-PART

JRG

MICHAEL BEST & FRIEDRICH LLP
100 E WISCONSIN AVENUE
Suite 3300
MILWAUKEE, WI 53202